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10/695,138

10/27/2003

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10/20/2008

EXAMINER

FONSECA, JESSIE T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/695,138 | Applicant(s) BOLTAN ET AL. | |
| | Examiner JESSIE FONSECA | Art Unit 3633 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings were received on 4/28/08. These drawings are not acceptable. The proposed replacement drawings include reference numerals that are not legible (i.e. Fig. 1E & 3D). Further, the replacement drawings are fuzzy making it difficult to interpret (i.e. Fig. 3L). As such, the objections to the drawings noted in the Office Action of 1/28/2008 remain and are reiterated below. Further, note the additional drawing objection below.

The drawings are objected to because each of the figures 3D, 3I, 4C, and 4F require bracketing "}". Also, reference numeral "24a" is missing a lead line in each of figures 3G, 3K, and 3L. Further, fig. 4G shows several modified forms/configurations of construction, which must be shown in separate figures.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Par. 0039, line 1: The sentence describing Fig. 1A to 1F appears incomplete. Examiner suggests replacing “show Universal” with --shows a Universal--.

Par. 0041: As the description is directed to more than one hard pole, it appears "a" should be deleted.

A period (.) appears to have been inadvertently inserted after several of the figure numbers (i.e. Fig. 1B.) in each of the following paragraphs: 0041- 0045, 0047-0049, 0051, 0053-0055, 0068-0075.

A space should be inserted between “Fig.” and the succeeding figure number in each of the following paragraphs: 0058-0067. Note a period (.) is missing after “Fig” in par. 0059 and a space was inadvertently added between “3” and “I” in par. 0063.

Par. 0076, line 1: It appears “Drawing” should be --Drawings-- as the reference numerals subsequently recited are found in several of the drawing figures. Further, the paragraph lists reference numerals found in the drawings, however, several reference numerals found in the drawings are not listed: 12e, 12f, and 14e.

Par. 0082, lines 3: It appears a space should be inserted between “Fig.” and “1D”.

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Par. 0083, lines 1: It appears a space should be inserted between "Fig." and "1D".

Par. 0085, Line 1, it appears a space should be inserted between "Fig." and "2A".
Further in Line 2: A period (.) is missing after "Figs".

Par. 0086, lines 1: It appears a space should be inserted between "Fig." and "3K".

Appropriate correction is required.

Claim Objections

Claim 17 is objected to because of the following informalities: The claim recites the soft light walls are triangular. However, the shape of the walls as disclosed and the drawings appear to be trapezoidal rather than triangular. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no disclosure, either written or shown, to describe an extension pole adapted for attachment to a distal end of the hand held lever to extend above the umbrella roof. Figs. 2B, 2D, and 2E shows a hand held lever sliding through the roof so as to allow for the capability of a lever extending above the roof, but there is no disclosure including an extension pole extending above a roof by attachment of a pole to the distal end of the hand held lever.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 13, 16, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dial (US 1,449,894)

With regards to claim 10: Dial further discloses in combination, a structure, comprising:

a umbrella tent structure which has a frame assembly including a lever (2) with a handle (20), and a plurality of umbrella arms (6) which extend outwardly radially and downward from a distal end of the lever which is spaced from the handle (27) of the lever (2) to free distal ends of the umbrella arms (6), and a soft material umbrella roof (28) which extends from the distal end of the lever (2) and over the umbrella arms (6)

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and to free distal ends of the umbrella arms (6), the umbrella roof terminating at the free distal ends of the umbrella arms (6) (figs. 1 & 2);

three or more hard poles (29) with “special appliances” (22) on first ends of the hard poles adapted for connection to the free distal ends of the umbrella arms (6) of the umbrella tent structure, the hard poles (29) extending downward from the distal ends of the umbrella arms to second ends, which is capable of having contact with a supporting surface;

one or more soft light walls attached to the hard poles (29) and extending downward from the umbrella roof at free distal ends of the umbrella arms (6) and from the umbrella roof and between the hard poles (29) to form an enclosure within the hard poles and with and under the umbrella roof, wherein the umbrella roof and one or more of the soft light walls form a substantially continuous enclosure or barrier supported by the hard poles (29) and the hand held umbrella frame assembly and extending from the distal end of the hand held lever (2) to the second ends of the hard poles (29) (figs. 1-2).

The umbrella tent of Dial having a lever (support) is capable of being hand held by a user. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regards to claim 13: Dial further discloses at least two soft light walls between the hard poles (29) extending from the free distal ends of the umbrella arms (6) (figs. 1-2).

With regards to claim 16: Dial further discloses each of the hard poles (29) comprises two or more interconnected telescoping sections whereby a length of each of the hard poles can be changed (fig. 1).

With regards to claim 19: Dial further discloses the hand held lever (2) is comprised of two or more interconnected telescoping sections (2, 27) whereby a length of the hand held lever can be extended to an approximate length of the hard poles (29).

As the telescoping section (27) receives the end of another member (2), the structure as a whole can be broadly interpreted as an interconnected telescoping section. Note as the hard poles are adjusted in length, the telescoping section (27) is capable of receiving the end of another member (2) at different degrees of length.

With regards to claim 20: Dial further discloses an extension pole (27) adapted for attachment to a distal end of the hand held lever. Claim is examined as best understood.

Claims 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp (US 2,059,463).

With regards to claim 21: Kemp discloses in combination, umbrella tent structure, comprising:

a umbrella tent structure (figs. 1-4) which has a frame assembly including a lever (12) with a handle (50) and a plurality of umbrella arms (60) which extend outwardly radially and downward from a distal end of the lever (12) which is spaced from the handle (50), each of the umbrella arms (60) terminating at free distal ends at radial

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points from the distal end of the lever (12) and a soft material umbrella roof (10) which extends over the umbrella arms (60) from the distal end of the lever (12) to each of the free distal ends of the umbrella arms (60). Note the free distal ends of the arms terminate at radial points as they extend from a common center and at a length equal to one another.

the hand held lever (12) further comprising two or more interconnected telescoping sections (50, 51) which extend from the handle to the distal end of the hand held lever (12) whereby a length of the hand held lever can be extended or shortened by relative movement of the interconnected telescoping sections (fig. 5);

three or more "soft pulls" (66) connected to the free distal ends of the umbrella arms (60) of the tent structure (fig. 7), the "soft pulls" extendable downward from the free distal ends of the umbrella arms (60) a distance greater than a length of the lever (12), and an anchor (69) at ends of each of the "soft pulls" (66).

The umbrella tent of Kemp having a lever (support) is capable of being hand held by a user. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regards to claim 22: Kemp further discloses the "soft pulls" (66) are attached to and extend from the free distal ends of the umbrella arms (60) which are located approximately ninety degrees apart on the umbrella frame assembly (fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dial (US 1,449,894) in view of Greenup (US 2,530,765).

With regards to claim 14: Dial discloses everything previously mentioned including soft walls, but fails to disclose the soft light walls extend between the hard poles and from the umbrella roof along an entire length of the hard poles to extend over substantially all of the area between the hard poles and from the umbrella roof to the second ends of the hard poles.

However, Greenup discloses soft light walls extending the entire length of the hard poles (40, 40a) to extend over substantially all of the area between the hard poles (40, 40a) and from the umbrella roof to the second ends of the hard poles (figs. 1 & 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the walls of Dial to have the soft light walls extend the entire length of the hard poles to extend over substantially all of the area between the hard poles and from the roof to the second ends of the hard poles as taught by Greenup in order to provide an enclosed structure that will allow for privacy and to provide protection from outside conditions (i.e. sunlight, wind, rain, insects, etc.).

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With regards to claim 18: Dial discloses everything previously mentioned, but fails to disclose the soft light walls are rectangular in shape.

However, Greenup discloses a structure have soft light walls being rectangular in shape (fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the soft light walls of Dial to extend soft light walls the length of the hard poles and be rectangular in shape as taught by Greenup in order to provide an enclosed structure that will allow for privacy and to provide protection from outside conditions (i.e. sunlight, wind, rain, insects, etc.). To have walls of a particular shape accommodate the framing in which it is placed is considered an obvious matter of design choice. Changing the shape of the soft light walls to accommodate a particular frame is considered within the level of ordinary skill in the art and would not be expected to yield new or unpredictable results.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dial (US 1,449,894) in view of Forget (US 4,033,366)

With regards to claim 15: Dial discloses everything previously mentioned, but fails to disclose the hand held lever is detachable from the umbrella frame assembly.

However, Forget teaches that at the time of the invention it was known that the central support of an umbrella tent may be detachable from the umbrella frame assembly as shown and described with respect to figure 6.

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the tend of Dial to have a lever (support, 2) detachable from the frame assembly as taught by Forget in order to provide a central support that can be removed so as to provide an open space within the tent structure when assembled.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dial (US 1,449,894) in view of Hoskins (US 2,928,403).

With regards to claim 17: Dial discloses everything previously mentioned, but fails to disclose the soft light walls are triangular in shape.

However, discloses a structure having a having a soft light walls being “triangular” (trapezoidal) in shape (figs. 1 & 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the walls of Dial to include trapezoidal shaped walls that correspond to angled hard poles as taught by Hoskins in order to provide an enclosed structure with greater floor surface area, which allows for privacy. Further, the soft light walls extending the entire length of the hard poles will provide the additional benefits of protection from outside conditions (i.e. sunlight, wind, rain, insects, etc.). To have walls of a particular shape accommodate the framing in which it is placed is considered an obvious matter of design choice. Changing the shape of the soft light walls to accommodate a particular frame is considered within the level of ordinary skill in the art and would not be expected to yield new or unpredictable results.

Response to Arguments

Applicant's arguments filed 4/28/08 have been fully considered but they are not persuasive.

Applicant argues Dial fails to disclose the claimed combination of a hand held umbrella and poles which extend from distal ends of the umbrella arms to provide an enclosure formed by the roof and "soft light walls". Applicant further argues that Dial does not disclose a "Collapsible Tent" or can be "hand held".

In response, Examiner submits the structure of Dial is collapsible as shown in fig. 4. In response to applicant's arguments that Dial fails to disclose a structure that can be hand held, Examiner's submits applicant's arguments appear to be directed to an intended use of the structure, the structure of Dial is capable of being hand held by a user. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further argues that Dial discloses no free distal ends on the arms. Examiner respectfully disagrees; the free distal ends applicant refers to are attached to hard poles via special connectors similar to applicants. As such, Examiner maintains the arms of Dial meet the claimed limitations.

Applicant further argues that Dial fails to disclose "two or more interconnected telescoping sections" and the pedestal 27 of Dial is not disclosed as an "extension

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pole". Examiner submits that Dial discloses a pedestal 27 which receives the end of another member (fig. 2) and is therefore considered telescoping. Note Dictionary.com defines telescoping as "consisting of parts that fit and slide one within another." Further, the pedestal of Dial is considered an extension pole as it is extension of the center support.

Applicant further argues that Kemp fails to disclose "soft pulls" that extend from the distal end of a lever from which the umbrella arms extend as defined by claim 21: "umbrella arms which extend outwardly radially and downward from a distal end of the hand held lever..." In response, Examiner submits that the claims do not recite the "soft pulls" extending from the hand lever, but instead recite the "soft pulls" are connected to free distal ends of the umbrella arms (lines 13-14 of claim 21).

Applicant further argues that Forget fails to disclose "hard poles" which extend from free terminal ends of the umbrella arms. Examiner submits that Forget is not relied on to teach hard poles, but rather to teach that is known in the art to have a detachable hand lever. Applicant's arguments are against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The objection to drawings regarding the claimed feature of at least two walls between each of hard pole (claim 13) has been withdrawn in view of the amendment to the claims filed 6/3/08.

The objection to the abstract has withdrawn in view of the amendment filed 6/3/08.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited is directed to umbrella and/or tent structures.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:30am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./
Examiner, Art Unit 3633

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635